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09/125,700	10/23/1998	THOMAS FUHRMANN	200-008181-U	8084

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NOKIA, INC.
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EXAMINER

CHIANG, JACK

ART UNIT

PAPER NUMBER

2642

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	09/125700	Applicant(s)	Fuhrmann et al.
Examiner	J. Chiang	Group Art Unit	2642
			# 2-

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on 10-9-02.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1-9, 11-13, 15-24 is/are pending in the application.
- Of the above claim(s) 18-24 is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1-9, 11-13, 15-17 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
- Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other Interview Summary

Office Action Summary

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to a specific layout of a phone structure (such as fig. 5), classified in class 379, subclass 433.01.
 - II. Claims 18-24, drawn to a detachable external (decorative type) housing wrapping around an electronic device (such as fig. 1), classified in class 379, subclass 433.11.
2. Inventions Group I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I is a phone structure, and Group II can be used to wrap any electronic device. The subcombination has separate utility such as wrapping a PDA.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Steven Shaw on 12-06-02 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17.

Mr. Shaw has acknowledged that this group of claims is meant to describe the phone structure shown in Fig. 5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-24 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

NOTE: Fig. 6 and its description filed on 10-09-02 have not been entered (see the argument section below).

CLAIMS

112 First Paragraph Rejection (Fig. 6 is not entered)

6. Claims 1-17 (drawn to fig. 5) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1, 15-17, they all claim a press-on catch. The original claims (1-14), the original Fig. 5 (it shows screws 43), and the original specification do not have a press-on catch for the phone structure itself. It uses screws 43, not press-on catch. Therefore, it is a new matter.

Art Rejection

102 Rejection (Fig. 6 is not entered)

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-9, 11-12, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al. (US 5722055).

Regarding claim 1, Kobayashi shows:

A first housing (23);

A second housing (25);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23), the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Regarding claim 15, Kobayashi shows:

A back housing (23);

At least one key unit (24);

At least one key sensor (41, 42);

A front housing (25);

At least one opening (see 25-1-7-1);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the back housing (23, see 54 in fig. 33) when the front housing (25) is released from the first housing (23);
the key unit (24) is held between the front and back housings (25, 23), and is free to move when the front housing (25) is released (see 50-51).

Regarding claim 16, Kobayashi shows:

A first housing (23);
A second housing (25);
At least one key unit (24);
At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23), the key unit (24) is sandwiched between the front and back housings (25, 23), and is free to move when the second housing (25) is released (see 50-51).

Regarding claim 17, Kobayashi shows:

A first housing (23);
A second housing (25);
Attachment means (50-51);
At least one key unit (24);
At least one key sensor (41, 42);
Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23), the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Regarding claims 2-9, 11-12, the combination of Kobayashi and Semenik shows:

The user interface second housing (25 in Kobayashi);

A circuit board (i.e. 41, 45);

The key sensor (see 41);

The cover, the components and the circuit board (43, 41, 45);

The releasable cover (see 43, 43-4);

The cover aperture (see 43);

A sealing member (ie 40);

the first housing (23);

the second housing (25);

the key unit which is a key mat (24); and

the key sensor (41, 42).

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Takagi et al. (US 523566).

Regarding claim 13, Kobayashi shows the key sensor (41, 42).

Kobayashi differs from the claimed invention in that it does not explicitly mention that the key sensor is a membrane type of key switch.

However, membrane type of key switch is one of the most common type of key switch, this is shown by Takagi (see 10). Hence, if it is found that Kobayashi is not the membrane type of switch, then it would have been obvious for one of ordinary skill in

the art to use the membrane type of switch in Kobayashi with/without the teaching of Takagi, because it is a conventional type of switch.

4. The following 103 rejection is drafted to assist applicant to understand the overall cited prior art which potentially cover the claimed material even if Fig. 6 is entered.

103 Rejection (If Fig. 6 is entered)

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9, 11-12, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5722055) in view of Semenik et al. (US 5233506).

Regarding claim 1, Kobayashi shows:

A first housing (23);

A second housing (25);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is

released from the first housing (23), the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

However, in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together. This is shown by Semenik (100, 200; or 500, 600). Hence, it would have been obvious for one skilled in the art to modify Kobayashi with a press-on/catch when assembling the first and second housings as taught by Semenik, because it is understood that cell phones are getting smaller, this is including reduction in size and mechanical structures, and such press-on/catch shown by Semenik achieves the function of attaching the housings together and yet to reduced dimensions (col. 1, lines 42-50, col. 2, lines 41-47 in Semenik).

Regarding claim 15, Kobayashi shows:

A back housing (23);

At least one key unit (24);

At least one key sensor (41, 42);

A front housing (25);

At least one opening (see 25-1-7-1);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the back housing (23, see 54 in fig. 33) when the front housing (25) is released from the first housing (23);

the key unit (24) is held between the front and back housings (25, 23), and is free to move when the front housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

However, in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together. This is shown by Semenik (100, 200; or 500, 600). Hence, it would have been obvious for one skilled in the art to modify Kobayashi with a press-on/catch when assembling the first and second housings as taught by Semenik, because it is understood that cell phones are getting smaller, this is including reduction in size and mechanical structures, and such press-on/catch shown by Semenik achieves the function of attaching the housings together and yet to reduced dimensions (col. 1, lines 42-50, col. 2, lines 41-47 in Semenik).

Regarding claim 16, Kobayashi shows:

A first housing (23);

A second housing (25);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23), the key unit (24) is sandwiched between the front

and back housings (25, 23), and is free to move when the second housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

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Regarding claim 17, Kobayashi shows:

A first housing (23);

A second housing (25);

Attachment means (50-51);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is

released from the first housing (23), the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

However, in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together. This is shown by Semenik (100, 200; or 500, 600). Hence, it would have been obvious for one skilled in the art to modify Kobayashi with a press-on/catch when assembling the first and second housings as taught by Semenik, because it is understood that cell phones are getting smaller, this is including reduction in size and mechanical structures, and such press-on/catch shown by Semenik achieves the function of attaching the housings together and yet to reduced dimensions (col. 1, lines 42-50, col. 2, lines 41-47 in Semenik).

Regarding claims 2-9, 11-12, the combination of Kobayashi and Semenik shows:

The user interface second housing (25 in Kobayashi);

A circuit board (i.e. 41, 45);

The key sensor (see 41);

The cover, the components and the circuit board (43, 41, 45);

The releasable cover (see 43, 43-4);

The cover aperture (see 43);

A sealing member (i.e. 40);

the first housing (23);

the second housing (25);
the key unit which is a key mat (24); and
the key sensor (41, 42).

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kobayashi and Semenik in view of Takagi et al. (US 523566).

Regarding claim 13, the combination of Kobayashi shows the key sensor (41, 42). Kobayashi differs from the claimed invention in that it does not explicitly mention that the key sensor is a membrane type of key switch. However, membrane type of key switch is one of the most common type of key switch, this is shown by Takagi (see 10). Hence, if it is found that Kobayashi is not the membrane type of switch, then it would have been obvious for one of ordinary skill in the art to use the membrane type of switch in Kobayashi with/without the teaching of Takagi, because it is a conventional type of switch.

ARGUMENT

In response to the remarks, in page 4, applicant cites page 4 lines 6-10, and original claims 10-11, and further states that ... new fig. 6 is fig. 5 with the matter identified as 43 removed, thus no new matter has been added.

First, page 4 lines 6-10 describes an external housing wrapping an electronic housing (fig. 1 of the present application). This is directed to the non-elected claims 18-24. The present claims 1-17 are directed to fig. 5. In other words, this portion of the

disclosure is not a support for the change in Fig. 6 and its description. Second, after removing screws 43 in fig. 5, what element(s) secure housings (18-19) together, and where is the original support for such change if screws 43 are not used? Third, original claims 10-11 are directed to the description of the key unit, and are describing fig. 5, they are fully supported by the original disclosure. However, these claims 10-11 are not the support for the new added Fig. 6 and its description.

In pages 5-6, applicant argues about claims 18-21 which are currently non-elected claims, therefore, no further discussion is made on these claims in this office action. However, if these claims are proceeded in future application, this 112 problem will be addressed.

In page 7, applicant first argues that ... Kobayashi ... there is no disclosure... to have user replaceable covers.... the phones from a manufacturing standpoint not from the user's standpoint. The examiner disagrees. Looking at Kobayashi's fig. 1, there are replaceable covers (25, 28). Further, the covers are secured by screws, it can be done by the manufacture or users.

In page 7, applicant argues that ... Semenik et al. also teaches away from user replaceable covers, columns 6-8 are cited, and states that "forces acting on the housing do not result in separation of the housing portions thereapart". Then applicant concludes that a person of ordinary skill in the art would not look to Semenik for a press-on/catch. First, the examiner agrees with applicant that, in Semenik, "forces acting on the housing do not result in separation of the housing portions thereapart".

Second, the examiner likes to ask applicant, in applicant's device, do "forces acting on the housing result in separation of the housing portions thereapart?

In page 7, applicant also argues that the housing assembly of Semenik is made to be fastened by the manufacture.... The examiner likes to guide applicant to Semenik's fig. 8, is it really a problem for one skilled in the art to use a screw driver 950 shown in Fig. 8? Further, in page 7 of the present application, when applicant describes the operation of the press-on/catch, it also uses a pointed object. Does it also mean that it is made to be fastened by the manufacture too?

In page 8, Takagi is cited to show other claimed feature, the covers are taught by the Kobayashi and Semenik.

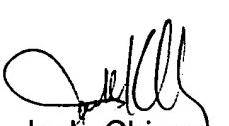
In page 8, applicant further cites an article from *WHAT MOBILE*, the examiner likes to ask applicant: what is the advantage of using a "pointed object" over the screwdriver? Second, Semenik is using a screwdriver to dislodge the press-on catch, is it possible to use "a pointed object" to dislodge Semenik's press-on catch? Third, screwdrivers can be very small, would that be considered as a "pointed object"?

In conclusion, it is believed that the claimed covers are met by Kobayashi and Semenik.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Admad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



Jack Chiang
Primary Examiner
Art Unit 2642

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

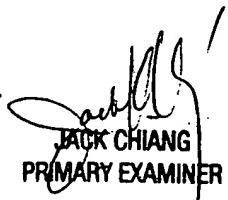
35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.


JACK CHIANG
PRIMARY EXAMINER